

REMARKS/ARGUMENTS

Claims 1-29, 67-69, and 71-78 were pending in the application of which claims 1, and 67 were independent claims. Claims 1-29 and 71 have been amended above and claims 79-88 have been added. The new and amended claims are fully supported by the specification and add no new subject matter. Claims 5-9 have been canceled. Accordingly, claims 1-4, 10-29, 67-69 and 71-88 are still pending of which claims 1 and 67 are independent claims.

Objections to the specification:

Paragraph 3 of the Action objects to the specification under 37 C.F.R. 1.71 for allegedly failing to disclose how one of skill in the art is to specify optimum golf equipment based on loft [031], load time [045], load pattern [039] to [043], shaft length, shaft materials, shaft torque, shaft weight, different grips, different grip weights [060], tip size [069], head center of gravity, ball, and head type [056]. Applicant respectfully asserts that the specification does teach how to specify optimum golf equipment based on the above, or more specifically, based on launch data obtained by changing these various parameters in order to obtain an optimal ball flight for a particular golf club.

First, with respect to the load time and load pattern, paragraphs [044] to [045] clearly indicate that these parameters can be used to specify a shaft flex for use in obtaining launch data. Paragraphs [050] to [063] then explain how, starting with the specified shaft flex, various golf club parameters can be changed based on the launch data in order to achieve an optimum ball flight. Paragraph [064] then explains that the

final set of parameters can then be used to specify golf equipment that should produce the optimum ball flight, i.e., to specify optimum golf equipment.

Thus, it is clear how the load time and load pattern can be inputs in to a process that results in the specifications for the optimum golf equipment for a particular golfer. For example, a golfer with a quicker than normal measured land time of <.45 seconds will generally benefit from a slightly heavier shaft weight in order to more consistently and accurately deliver the head to the ball. Players with a flatline load patten will benefit from specific instructional drills as well as a lighter weight shaft, etc.

Applicants must point out however that the claims as amended or not, are not necessarily directed to specifying optimum golf equipment based on load time or load pattern. Rather, the load time and load pattern are more specifically used to determine whether the golfer's swing technique should be modified before trying to fit the golfer with equipment. In conventional systems, the golfer is fit for their swing. (See, e.g., paragraph [003] of the present application). But as Applicants point out, this leads to ineffective club fitting when the golfer has pronounced swing flaws. (See paragraph [005]).

For example, conventional methods simply fit golfers for the swing they came in with and thus specify equipment that basically condemns players to faulty habits that severely limit their potential. Another example: if a player's swing time is too long their backswing is almost always too long which creates a situation where their arms separate from their body in a disconnect. This extra arm lift almost always leads to an early thrust from the top of the back swing with the arms and creates a steep angle of attack that in turn is likely to impart too much spin on the ball. A combination of specific swing

adjustments and a correct shaft tip selection can quickly combine to find the numerical values that will lead to optimized ball velocity, launch angle, and spin rate.

Thus, the load time and load pattern, in conjunction with other parameters, can be used to identify swing flaws and determine appropriate swing corrections before fitting and in order to achieve a better fit. (See paragraphs [039]-[049]).

With regard to the remaining parameters, paragraphs [050] to [063] clearly describe how these various parameters can be modified until an optimum ball flight is achieved. Thus, it is clear that once an optimal ball flight is achieved, then the final parameters can be used to specify optimum golf equipment. In particular, loft is discussed in paragraph [058], and the shaft length, shaft materials, shaft torque, shaft weight, different grips, different grip weights are discussed in paragraph [056] and in relation to figure 3.

Accordingly, Applicants respectfully request withdrawal of the objections of paragraph 3.

Objections to the Claims:

Paragraph 4 of the Action objects claim 71 for depending on a cancelled claim. Applicant has amended claim 71 in order to properly depend on claim 69. Accordingly, Applicants respectfully request withdrawal of the objection.

Claim Rejections Under § 112:

Paragraph 6 of the Action rejects claims 1-39, 67-69, and 71-78 under 35 U.S.C. 112, first paragraph, for allegedly failing to comply with the written description requirement.” Applicants have cancelled claims 5-9 thereby rendering the rejection moot

as to these claims. Applicants therefore respectfully request withdrawal of the rejection of claims 5-9; however, Applicants expressly reserve the right to pursue any patentable subject matter included in claims 5-9 at a later time. With respect to the remaining claims, Applicants traverse the rejection because the Application clearly provides adequate written description in support of the claims.

MPEP § 2163 (III)(A) states, “A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. *See, e.g., In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). Further, the Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an Applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.”

MPEP §2163 continues stating, “In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should: (A) Identify the claim limitation at issue; and (B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of ‘unpredictability in the art’ is not a sufficient reason to support a rejection for lack of adequate written description.” Furthermore, there is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed. (*Wertheim*, 541 F.2d at 262.) Consequently, rejection of an original claim for lack of written description should be rare. (MPEP § 2163.03).

First, the rejection as to claims 2 and 10-27 must fail because the Action fails to provide reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. In each instance, the Action simply states it is uncertain how these claims are supported. Applicants disagree.

Second, with respect to claims 1-29, the Action states that “it is uncertain how to modify the golf club characteristics based on launch data to optimize a launch angle, velocity, and spin rate relative to each other by determining an appropriate velocity based on the launch angle or spin rate.” Applicants have amended claim 1 such that this specific limitation is no longer necessarily part of the claim, thereby rendering this rejection moot; however, Applicants also traverse this rejection because one of skill in the art at the time the application was filed would understand after reading Applicants’ specification how to modify the golf club characteristics based on launch data to optimize a launch angle, velocity, and spin rate relative to each other by determining an appropriate velocity based on the launch angle or spin rate. Thus, one of skill in the art at the time the application was filed would understand that Applicant was in possession of the invention as claimed.

For example, paragraph [054] states that launch data can be collected and used to fine tune a golfer’s equipment to achieve an optimum ball flight. This paragraph goes on to state that for example with a driver the golfer should be trying to maximize distance while maintaining accuracy and consistency, which requires matching the golfer’s speed to an optimized combination of launch angle and spin rate. This provides more than enough written description for the limitation at issue.

With respect to claim 2, clearly the golfer's ability is going to dictate what type of instruction is provided to the golfer. Paragraph [028] to [029] describe using this data in evaluation of the golfer's swing technique.

With respect to claims 10-27, the process described in relation to figure 3 describes how these various parameters can be changed in order to achieve an optimal ball flight. More specifically, paragraph [050] clearly states that launch data includes velocity, spin rate, and launch angle information. Paragraph [052] clearly indicates that this data can be used to derive information about the ball flight. Paragraphs [054] to [056] clearly indicate that each parameter at issue can be changed, through changes in the golfer's equipment, and then new launch data can be obtained until optimum ball launch conditions, i.e., speed, spin, launch angle, side spin, dispersion, etc., which lead to an optimum ball flight, is achieved as indicated by the launch data, or more specifically the ball flight characteristics derived therefrom. Thus, it is clear that by analyzing the launch data, new club characteristics can be selected and used to obtain more launch data, until an optimum ball flight is achieved.

With respect to claims 1-39 and 73-75, as well as 67-78 the Action states that it is uncertain how to specify golf equipment as claimed in the claims. Applicants respectfully disagree. The entire specification is replete with descriptions of the various parameters for all parts of the golf club that can be changed to produce an optimum ball flight. Clearly, specifying golf equipment then involves no more than specifying the parameters that produced the optimum ball flight.

With respect to claims 67-78, it is clear for the same reasons described above, how to select a golf club head based on various parameters such as club head center of

gravity, as well as how to select a shaft. The statements that there is no description of how to do so, or examples of how it is done, or that only certain other parameters are described as being changed is incorrect.

Accordingly, Applicants respectfully submit that claims 1-4, 10-35, 67-69, and 71-78 meet the relative minimal requirements of 35 USC §112, first paragraph and respectfully requests withdrawal of the rejection.

Paragraph 9 of the Action rejects claims 1-29 under U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Although, the Applicants believe that the original pending claims were sufficiently definite, claim 1 has been amended such that the rejection has been rendered moot. As for claim 2, the claim is sufficiently definite as required by U.S.C. § 112, second paragraph for the reasons described above.

For at least the above reasons, Applicants believe that claims 1-29 are definite. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-29.

Claim Rejections Under § 103:

Paragraph 11 of the Action rejects claims 1, 5, and 28-29 under 35 U.S.C. §103(a) as allegedly being obvious over Anderson (U.S. Patent Publication 2003/0008731) in view of Gobush (U.S. Patent No. 6,758,759) in further view of Cervantes (U.S. Patent No. 5,779,556). Applicants have cancelled claim 5 thereby rendering this rejection moot as to claim 5. Applicants therefore respectfully request withdrawal of the rejection of claim 5; however, Applicants expressly reserve the right to pursue any patentable subject matter included in claim 5 at a later time. With respect to the remaining claims, Applicants respectfully traverse the rejection because Anderson in further view of Gobush and Cervantes fails to make out a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order to allege a claim is obvious when references are combined under 35 U.S.C. 103(a) the combination must teach each and every limitation of the claim. In this case, the rejection must fail because Anderson and Gobush alone or in combination, fail to teach each and every element of the claims as amended. Moreover, the references

actually teach away from the claimed combinations and fail to provide any motivation to combine the references in a manner that would render the claims obvious.

For example, certain embodiments of the present application are directed to a method for fitting a golfer with a golf club in which a baseline configuration of club head, shaft, grip, and ball are used and the results of using the baseline configuration are monitored. (See, e.g., the description of figure 2 in the present application). In particular, swing data such as a load time and load pattern can be used to select, e.g., a shaft flex for the baseline configuration. (See, e.g., see paragraph [0045]). The monitoring can include monitoring of launch information such as launch angle, velocity, and spin. (See, e.g., paragraph [0052]). The monitored information can then be used to, e.g., select at least one of a new golf shaft or club head in order to optimize the velocity, spin, and launch angle relative to each other. (See, e.g., paragraphs [0052]-[0056]).

More specifically, the embodiments described in the present application disclose a method in which a load time, load pattern, ramp potential, etc., are used to determine whether the golfer's swing technique should be modified. For example, as described in paragraphs [039] to [043], various load patterns can be detected and used to identify swing flaws. The swing flaws associated with the load patterns can then be used to suggest changes in swing technique. Once the golfer's load pattern more closely resembles a proper incline load pattern, then the swing parameters, e.g., load time, load pattern, ramp potential, etc., can be used to specify a shaft flex for use in further fitting the golfer with golf equipment. (See paragraph [045]).

As described with respect to figure 3, a golf club can then be selected or assembled (paragraphs [060] to [062]) that includes a shaft flex, e.g., determined based on

the swing data. The golf club can then be swung by the golfer and launch data can be obtained. The launch data, i.e., velocity, spin rate, and launch angle, can then be used to fine tune the shaft flex determination (paragraph [054]) as well as to specify other club aspects. For example, as described in paragraphs [054] to [063] various aspects of the club can be changed until an optimum ball flight is achieved as indicated by the launch data. Once an optimum ball flight is achieved, then the final parameters can be used to specify a golf club optimized for the golfer. (See paragraph [064]).

What constitutes optimum ball flight can vary based, e.g., on the club being swung. For example, for a driver an optimum ball flight can be defined as one that achieves the greatest distance, while maintaining control and consistency. (See paragraph [054]). For irons, the key is not distance as much as a tight dispersion and consistent distance gaps from one iron to the next, while still maintaining control and consistency. (See paragraph [057]). For wedges, maximizing spin or launch angle can be more optimum. (See paragraph [058]).

But as described, whereas one golfer may need to increase spin to, e.g., increase distance with a driver, another may need to decrease spin, even if, e.g., they have the same swing speed. For example, the two golfers may produce different launch angles, which can effect the distance. (See, e.g., paragraph [056]). Moreover, two different golf clubs, fitted with the same parameters, e.g., shaft stiffness, can produce different results when swung by the same golfer. (See, e.g., paragraph [055]). Further, e.g., different tip sections of equal flex shafts can have a dramatic effect.

Thus, in order to fit a particular golfer with optimum golf equipment for them, various aspects of the golf club must be changed and tested to determine their effect on

the ball flight produced. (See description of figure 3). And more importantly, it is not a simple matter of, e.g., maximizing speed in order to gain distance. Rather, an optimum combination of spin rate and launch angle must still be determined, then a maximum swing speed for the optimum combination of spin rate and launch angle can be determined, while ensuring that control and consistency are not sacrificed. (See paragraph [054]).

In general, figures 1-3, and specifically figure 3, and the accompanying description depicts and describes a process in which the various club aspects that effect speed, spin, and launch angle can be alternately and repetitively changed and then tested to see their effect on the ball flight, always with an optimum ball flight to be achieved in mind. Once the optimum ball flight is achieved using a particular set of club parameters, then that set of parameters can be used to specify a golf club that comprises those parameters. (See paragraph [064]).

Accordingly, claim 1 is directed to a “method for fitting golf equipment, comprising collecting data related to the golfer's swing, the swing data comprising a load time, load pattern, peak load, swing ramp, and ramp potential or a combination of at least some of these parameters, determining if the golfer's swing technique should be modified based at least in part on the collected swing data, when it is determined that the golfer's swing technique should be modified, then using the swing data to correct the swing flaws, and when it is determined that the golfer's swing technique should not be modified, then monitoring how the golfer launches a golf ball using a particular golf club to obtain launch data including a launch angle, velocity, and spin rate, and changing one or more

aspects of the golf club in order to change any of the launch angle, velocity and spin rate so as to achieve an optimal ball flight characteristic for the given golf club.”

Conversely, Anderson, Gobush and Cervantes, alone or in combination, fail to teach such optimization. First, each of the above references not only fails teach the invention claimed in the present application, e.g., in claim 1, Anderson, and Cervantes specifically teach away from the invention as claimed. Put simply, Anderson and Cervantes are not directed to methods for determining whether a golfer’s swing technique should be modified based on certain swing data, and then once the golfer’s swing has been appropriately modified, changing club parameters in order to optimize launch data in order to achieve an optimum ball flight.

Rather, Anderson is directed to a fitting process the specific goal of which is to fit a golfer for golf equipment based on their specific swing type, i.e., swing flaws included. (See the Abstract, Field of the Invention, and paragraphs [004], [034], [050], and [051]). In fact, in paragraph [045] Anderson expressly distinguishes his system from systems in which the swing data is used to improve a golfer’s swing, i.e., the purpose of the embodiments disclosed in Anderson are not to correct a golfer’s swing, but rather to provide a quick, automated manner in which to fit a golfer for their swing type, i.e., with their swing flaws. (See paragraph [051]). This is the antithesis of what is taught and described in the present application.

In short, Anderson simply teaches quickly collecting certain swing data and then quickly specifying club characteristics based thereon. Anderson is not concerned with achieving an optimum ball flight and does not teach changing certain club aspects in order to achieve an optimum ball flight by changing the velocity, spin, and launch angle.

Cervantes simply teaches monitoring where on the club face the golfer strikes a ball and then trying to modify the golfer's swing technique in order for the golfer to hit the ball in the center of the club face. The adjustment disclosed being the fairly rudimentary adjustment of adjusting the golfer's stance. But again Cervantes fails to teach achieving an optimum ball flight and does not teach changing certain club aspects in order to achieve an optimum ball flight by changing the velocity, spin, and launch angle.

Gobush teaches a launch monitor system that can be used to gather launch data, such as velocity, spin, and launch angle. But this is merely what a launch monitor does. While it should be noted that Applicants did in fact have to develop their own patented launch monitor (see U.S. Patents 7,159,451 and 7,166,035) in order to effectively carry out the methods described in the present application, Applicants are not asserting that launch monitors were unknown or that they were not used to collect data such as velocity, spin, and launch angle. It is what is done with the information that matters.

Gobush does make reference to using the information for teaching and fitting purposes (see col. 14, lines 32-34) and to determining what effect changing the launch conditions would have on the result. (See col. 8, lines 59-62); however, Gobush does not teach how to use the information for teaching and fitting, nor as described above do Anderson or Cervantes. Nor does Gobush teach how to effect changes in the launch conditions, with the possible exception of changing the ball. (See col. 8, lines 57-59).

The Action states that it would have been obvious to one of skill in the art to modify the fitting process of Anderson with the step of determining if a golfer's swing technique should be modified and provide swing instruction to a golfer if a golfer's swing

technique should be modified in light of Gobush and Cervantes. What the Action fails to take into account is that Anderson expressly is not interested in modifying a golfer's swing technique, but rather is interested in fitting a golfer based on their existing technique. Therefore, one of skill in the art at the time that application was filed would not be motivated to modify Anderson in this manner.

Further, the Action fails to take into account the fact that Cervantes and Gobush do not teach determining if a golfer's swing technique should be modified based on the parameters claimed, e.g., in claim 1 of the present application.

The Action goes on to state that Gobush teaches modifying club characteristics based on the launch angle, velocity, and spin rate relative to each other by determining an appropriate velocity based on the launch angle or spin rate, testing new clubs, where one of the elements of golf performance is carry distance and directional accuracy, citing to figure 8 steps S111 and S115; however, these statements misrepresent the contents of Gobush and appear to be based on improper hindsight gained after reading Applicants' disclosure. As noted, step S111 has to do with what effect changing the golf ball may have on the launch characteristics, and step S115 simply states that a golfer can be presented with ideal launch conditions (obtained via computer simulation and not through testing as taught in the present application), allowing the golfer to make changes and maximize distance; however, Gobush does not indicate what type of changes, e.g., swing technique changes or golf club parameter changes are to be made. In fact, the examples given are of changing the golfer's technique. (See col. 14, lines 59-61, and col. 18, lines 56-58). If this sentence in Gobush is referring to changing golf club parameters, it does not indicate how to change them and certainly does not indicate how to change them in

order to optimize the velocity, spin, and launch angle in order to achieve an optimized ball flight.

Gobush does indicate that the test can be restarted with a new club. (See col. 9, lines 4-6). But this appears to mean that once the golfer is finished testing his 4-iron, he can test his 5-iron, and so on. In any event, nothing in Gobush references, refers to, or even hints at methodically changing various parameters of a golf club in an effort to effect the velocity, spin, and launch angle in order to optimize ball flight. In other words, the system of Gobush could be used to obtain the launch data used in the embodiments described in the present application, but it does not teach how to use that launch data in order to achieve the invention claimed in the present application. At best, it simply indicates that such optimization could take place.

To summarize, neither Anderson, Cervantes, or Gobush, alone or in combination, teach collecting swing data including a ramp time, load pattern, peak load, swing ramp, or a combination thereof and using is to determine if a golfer's swing technique should be modified based at least in part on the collected swing data. Nor do they teach, alone or in combination, obtaining launch data including velocity, spin and launch angle and changing one or more aspects of a golf club to change the launch data in order to obtain an optimum ball flight. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1 and 28-29.

Paragraph 12 of the Action rejects claim 2 under 35 U.S.C. 103(a) as allegedly being unpatentable over Anderson in view of Gobush in further view of Cervantes in still further view of Sayers (U.S. Patent No. 4,059,270). Applicants traverse this rejection because claim 2 ultimately depends from amended claim 1 and is therefore allowable for

at least the same reasons as amended claim 1, unless Sayers makes up for the deficiencies of Anderson, Gobush and Cervantes which it does not. Accordingly, Applicants respectfully request withdrawal of the rejection as to claim 2.

Paragraph 13 of the Action rejects claims 3-4 under 35 U.S.C. 103(a) as allegedly being unpatentable over Anderson in view of Gobush in further view of Cervantes in still further view of Sayers in still further view of Nauck (U.S. Patent No. 5,616,832) in still further view of Naruo (U.S. Patent No. 5,812,417). Applicants traverse this rejection because claims 3 and 4 ultimately depend from amended claim 1 and are therefore allowable for at least the same reasons as amended claim 1, unless Sayers, Nauck and Naruo make up for the deficiencies of Anderson, Gobush and Cervantes which they do not. Accordingly, Applicants respectfully request withdrawal of the rejection as to claims 3-4.

Paragraph 14 of the Action rejects claims 6-9 under 35 U.S.C. 103(a) as allegedly being unpatentable over Anderson in view of Gobush in further view of Cervantes in still further view of Sayers in still further view of Naruo. Applicants traverse this rejection because claims 6-9 have been cancelled thereby rendering this rejection moot. Accordingly, Applicants respectfully request withdrawal of the rejection as to claims 6-9; however, Applicants expressly reserve the right to pursue any patentable subject matter included in claims 6-9 at a later time.

Paragraph 15 of the Action rejects claims 10-27 under 35 U.S.C. 103(a) as allegedly being unpatentable over Anderson in view of Gobush in further view of Cervantes in still further view of Examiner's Official Notice. Applicants traverse this rejection because claims 10-27 ultimately depend from amended claim 1 and are

therefore allowable for at least the same reasons as amended claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection as to claims 10-27.

Moreover, Official Notice without documentary evidence to support an examiner's conclusion is permissible only in **rare** circumstances when an application is under final rejection or action under 37 CFR 1.113 (see MPEP 2144.03). Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

Furthermore it is never appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. (see MPEP 2144.03). For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.").

Additionally, it is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."). As the court held in Zurko, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. Id. at 1385, 59 USPQ2d at 1697.

Here, the question is not simply whether it is known to fit a club to a golfer by selecting the various parameters mentioned, but whether it would have been obvious to change these parameters in order to optimize the velocity, spin rate, and launch angle relative to each other in order to achieve an optimum ball flight. As the teachings of, e.g., Anderson, Cervantes and Gobush show, or more specifically what they do not show, it was not obvious at the time the application was filed, the unsupported statements of paragraph 15 notwithstanding.

Accordingly, Applicants respectfully request withdrawal of the rejection as to claims 10-27 for the additional reason that the unsupported Official Notice is not sufficient to support a *prima facie* case of obviousness in this instance.

Paragraph 15 of the Office Action rejects claims 67-69 and 78 under 35 U.S.C. §103(a) as allegedly being obvious over Anderson in view of Gobush in further view of Pelz (U.S. Patent No. 5,039,098). Applicants respectfully traverse the rejection because Anderson, Gobush, and Pelz fails to make out a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order to allege a claim is obvious when references are combined under 35 U.S.C. 103(a) the combination must teach each and every limitation of the claim. In this case, the rejection must fail because Anderson, Gobush, and Pelz, alone or in combination, fail to teach each and every element of the claims as amended.

For example, certain embodiments of the present application are directed to a method for fitting a golfer with a golf club in which a baseline configuration of club head, shaft, grip, and ball are used and the results of using the baseline configuration are monitored. (See, e.g., the description of figure 2 in the present application). The monitoring can include monitoring of launch information such as launch angle, velocity and spin. (See, e.g., paragraph [0052]). The monitored information can then be used to select at least one of a new golf shaft or club head in order to optimize the velocity, spin, and launch angle relative to each other. (See, e.g., paragraphs [0052]-[0056]).

This optimization can include optimizing the velocity based on the launch angle and/or spin rate. (See Paragraph [054]). Thus, claim 67 as amended is directed to a

method of fitting a golfer with a golf club in which a baseline club configuration is used and the resulting launch parameters are monitored to determine how the golfer launches a golf ball using the new golf club “wherein monitoring how the golf club launches a golf ball comprises monitoring the spin, velocity, and launch angle imparted to the golf ball by the golfer using the golf club, the new golf club head or golf club shaft being selected based on the monitoring in order to optimize a launch angle, velocity and spin rate relative to each other by determining an appropriate velocity based on the launch angle or spin rate.”

Conversely, Anderson, Gobush, and Pelz, alone or in combination, do not teach such optimization. The Action admits that Anderson and Pelz do not teach such optimization and relies on Gobush to provide these missing limitations of, e.g., claims 67; however, as discussed above, Gobush also does not teach these limitations. Accordingly, Applicants believe that claim 67 as amended is allowable over the art of record. Claims 68-69, 71-72 and 78 depend from claim 67 are therefore allowable for at least the same reasons as claim 67. Applicants therefore respectfully request withdrawal of the rejection of claims 67-69, 71-72 and 78.

Paragraph 17 of the Action rejects claim 73 under 35 U.S.C. 103(a) as allegedly being unpatentable over Anderson in view of Gobush and Pelz in further view of Holls (U.S. Patent No. 3,556,533). Applicants traverse this rejection because claim 73 ultimately depends from amended claim 67 and is therefore allowable for at least the same reasons as amended claim 67, unless Holls makes up for the deficiencies of Anderson, Gobush, and Pelz which it does not. Accordingly, Applicants respectfully request withdrawal of the rejection as to claim 73.

Paragraph 18 of the Action rejects claim 74 under 35 U.S.C. 103(a) as allegedly being unpatentable over Anderson in view of Gobush and Pelz in further view of Examiner Official Notice. Applicants traverse this rejection because claim 74 ultimately depends from amended claim 67 and is therefore allowable for at least the same reasons as amended claim 67. Further, the Examiner's Official Notice is insufficient to form a *prima facie* case of obviousness for the same reasons as described above. Accordingly, Applicants respectfully request withdrawal of the rejection as to claim 74.

Paragraph 19 of the Action rejects claim 75 under 35 U.S.C. 103(a) as allegedly being unpatentable over Anderson in view of Gobush and Pelz in further view of Naruo (U.S. Patent No. 5,821,417) in further view of Examiner Official Notice. Applicants traverse this rejection because claim 75 ultimately depends from amended claim 67 and is therefore allowable for at least the same reasons as amended claim 67, unless Nauro makes up for the deficiencies of Anderson, Gobush, and Pelz which it does not. Further, the Examiner's Official Notice is insufficient to form a *prima facie* case of obviousness for the same reasons as described above. Accordingly, Applicants respectfully request withdrawal of the rejection as to claim 75.

Paragraph 20 of the Action rejects claims 67-69, 71-72 and 76-77 under 35 U.S.C. 103(a) as allegedly being unpatentable over Anderson in view of Ashcraft (U.S. Patent No. 5,513,844) and Gobush. Applicants respectfully traverse the rejection because Anderson in further view of Ashcraft and Gobush fails to make out a *prima facie* case of obviousness from the same reasons that Anderson, Gobush, and Pelz fail to make out a *prima facie* case of obviousness. Namely, Anderson, Ashcraft, and Gobush, alone or in combination, do not teach the optimization required by the claims. The Action admits

that Anderson and Ashcraft do not teach such optimization and relies on Gobush to provide these missing limitations of, e.g., claims 67; however, as discussed above, Gobush also does not teach these limitations. Accordingly, Applicants believe that claim 67 as amended is allowable over the art of record. Claims 68-69, 71-72 and 76-77 depend from claim 67 are therefore allowable for at least the same reasons as claim 67. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 67-69, 71-72, and 76-77.

CONCLUSION

Based on the above amendments and remarks, Applicants believe that the claims are in condition for allowance and such is respectfully requested. The Commissioner is hereby authorized to charge any additional fees required by this response to our Deposit Account No. 13-0480 (Attorney Docket No. 67175523-001102).

Respectfully Submitted,

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